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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LINDA I. HOFFBERG-BORGHESANI and
STEVEN M. HOFFBERG

Appeal 2010-002510
Application 09/497,071
Technology Center 2400

Before MURRIEL E. CRAWFORD, HUBERT C. LORIN, and
MEREDITH C. PETRAVICK, *Administrative Patent Judges*.

PETRAVICK, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Linda I. Hoffberg-Borghesani et. al., (Appellants) seek our review under 35 U.S.C. § 134 (2002) of the final rejection of claims 155-193. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM-IN-PART and enter a new grounds of rejection pursuant to 37 C.F.R. § 41.50(b). [1]

THE INVENTION

This invention is applications of systems and methods that are adaptive to a human user input. Spec. 2:12-16.

Claims 155 and 162, reproduced below, are illustrative of the subject matter on appeal.

> 155. A method for selecting media, comprising the steps of:
>
> storing data describing available media and storing data representing previously selected media;
>
> automatically performing a search of said available media for a correspondence to data representing content characteristics of the previously selected media, wherein said data representing content characteristics are not received as an input from a human user; and
>
> automatically issuing a notification of available

[1] Our decision will make reference to the Appellants' Appeal Brief ("App. Br.," filed Sep. 26, 2008) and Reply Brief ("Reply Br.," filed Mar. 30, 2009), and the Examiner's Answer ("Ans.," mailed Jan. 29, 2009).

media having characteristics corresponding to, but not identical to previously selected media.

wherein said media comprises a media program.

162. A system, comprising:

a controller component configured to control delivery of a media program; and

a processor component configured to automatically determine a correspondence between data representing content characteristics of media within a set of available media programs with data representing content characteristics of previously delivered media, wherein said data representing content characteristics are not received as input from a human user, and producing a signal dependent on a degree of said correspondence.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Campbell	US 4,536,791	Aug. 20, 1985
Young	US 4,706,121	Nov. 10, 1987
Wachob	US 5,155,591	Oct. 13, 1992
Vogel	US 5,253,066	Oct. 12, 1993

The following rejections are before us for review:

1. Claim 177 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and

distinctly claim the subject matter which applicant regards as the invention.

2. Claims 166-168, 177, 187, and 190-193 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.
3. Claims 155-156, 160-165, and 174-189 are rejected under 35 U.S.C. § 102(e) as being anticipated by Vogel.
4. Claims 157-159 and 166 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Vogel and Young.
5. Claims 167 and 190-191 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Vogel and Campbell.
6. Claims 168-173 and 192-193 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Vogel and Wachob.

ISSUES

The first issue is whether claims 175, 177, and 178 are indefinite under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the issue is whether the step of "automatically determining a degree of correspondence between data representing content characteristics a member of the set of available media programs and the data representing content characteristics of previously selected media" recited in claim 177 is indefinite.

The second issue is whether the Examiner has established a prima facie showing that claims 166-168, 177, 187, and 190-193 fail to comply with the written description requirement of 35 U.S.C. § 112, first paragraph.

The third issue is whether the Examiner erred in rejecting claims 155, 156, 160, 161, 174 and 176 are rejected under 35 U.S.C. §102(e) as being anticipated by Vogel.

The fourth issue is whether the Examiner erred in rejecting claim 162-165, 175 and 177-189 under 35 U.S.C. § 102(e) as being anticipated by Vogel. The rejection of claims 167 and 190-191 under 35 U.S.C. § 103(a) as being unpatentable over Vogel and Campbell and the rejection of claims 168-173 and 192-193 under 35 U.S.C. § 103(a) as being unpatentable over Vogel and Wachob also turn on this issue.

The fifth issue is whether the Examiner erred in rejecting claims 157-159 under 35 U.S.C. § 103(a) as being unpatentable over Vogel and Young.

FINDINGS OF FACT

We find that the findings of fact which appear in the Analysis below are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

ANALYSIS

The rejection of claim 177 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention

We hold that claim 177 is indefinite under 35 U.S.C. § 112, second paragraph. Claim 177 recites a step of "automatically determining a degree of correspondence between data representing content characteristics a member of the set of available media programs and the data representing

content characteristics of previously selected media." The Examiner and the Appellants both set forth different interpretations of claim 177 when read in light of the Specification. The Examiner's interpretation requires the insertion of a comma between "content characteristics" and "a member." *See* Ans. 4 and 19-20. The Appellants' interpretation requires the insertion of the word "of" at the same location. *See* App. Br. 13-15 and Reply Br. 2-3. However, as the claim is currently pending neither the comma nor the word "of" appears in the claim. Therefore, we find that claim 177 does not set out and circumscribe a particular area with a reasonable degree of precision and particularity when read in light of the application disclosure as they would be interpreted by one of ordinary skill in the art. *In re Moor*e, 439 F.2d 1232, 1235 (CCPA 1971). Accordingly, the rejection of claims 177 under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention is affirmed.

For the same reasons as discussed above, we enter a new ground of rejection on dependent claims 175 and 178 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 175 and 178 depend on claim 177 and therefore, include the same limitation at issue above.

The rejection of claims 166-168, 177, 187, and 190-193 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement

The Examiner rejected claims 166-168, 177, 187, and 190-193 under 35 U.S.C. § 112, first paragraph by stating:

> The Examiner has reviewed the entire specification in regards to claims 166-168, 177, 187, and 190-193 including Column 65, Line 8 through Column 71, Line 50 and Figure 24 of the specification, which the claimed invention is specifically drawn to and no support can be found for the claims.

Ans. 4-5. We note that in the rejection the Examiner gives no notice of the limitations or portion of the limitations of these claims, which the Examiner finds to be unsupported by the Specification. *Id.* For example, claims 168 and 177 are independent claims which recite multiple limitations. Further, claims 166, 167, 187, 190-193 are dependent claims with limitations which are directed to various elements of the invention. It is not until the Examiner's response to the Appellants' argument, which set forth a rationale where in the Specification these limitations are supported (*See* App. Br. 15-33 and Reply Br. 3-6), that the Examiner argues that: 1) it is not the limitations recited in the independent claims *per se*, but the combination of the limitations in the independent claims 168 and 177 which it is not supported by a single embodiment of the Specification, and 2) that the limitations recited in the dependent claims *per se* that are not supported by the Specification but that it is the combination of the dependent claims and the limitations recited in their corresponding independent claims, that is not supported by a single embodiment of the Specification. *See* Ans. 20- 28. This rationale is not expressed nor implied by the rejection, which is reproduced above. Therefore, we find that the Examiner failed to establish a prima facie showing that claims 166-168, 177, 187, and 190-193 fail to

comply with the written description requirement of 35 U.S.C. § 112, first paragraph. Accordingly, the rejection of claims 166-168, 177, 187, and 180-193 under 35 U.S.C. § 112, first paragraph, is reversed.

The rejection of claims 155, 156, 160-165, and 174-189 under 35 U.S.C. § 102(e) as being anticipated by Vogel

Claims 155, 156, 161, and 174

The Appellants argued claims 155, 156, 161, and 174 as a group. *See* App. Br. 38. We select claim 155 as the representative claim for this group, and the remaining claims 156, 161, and 174 stand or fall with claim 155. 37 C.F.R. § 41.37(c)(1)(vii) (2010).

The Appellants and the Examiner dispute whether claim 155 is anticipated by Vogel. *See* App. Br. 34-38, Reply Br. 7-8, and Ans. 28-32. We are not persuaded by the Appellants that the Examiner erred in finding that Vogel anticipates claim 155, because the Appellants' arguments are not commensurate with the scope of the claims.

First, the Appellants argue that Vogel only discloses storing data representing previously selected media for a transiently stored time. App. Br. 34. Claim 155 recites "storing data representing previously selected media." Claim 155 does not define or restrict how long or where this data is stored. Further, we note that the searching step of claim 155 does not require the use of this data, but instead recites "data representing content characteristics of the previously selected media."

Second, the Appellants argue that Vogel does not describe a search that returns "two available media with identical 'data representing content characteristics.'" App. Br. 35. However, we see nothing in claim 155 that

requires this. Claim 155 recites a step of "automatically performing a search of said available media for a correspondence to data representing content characteristics of the previously selected media." Claim 155 does not restrict or define how the search of the available media is performed or that a correspondence requires that the data be identical.

Finally, the Appellants argues that claim 155 requires that the "automatically issued notification excludes identical 'previously selected media.'" App. Br. 38. However, we see nothing in claim 155 that requires the notification to exclude media that is identical to the previously selected media. Claim 155 only requires that the notification has "available media having characteristics corresponding to, but not identical to previously selected media" and does not preclude the notification from having other information. Further, we note that claim 155 does not require the notification contain the results of the search recited in the previous step.

We agree with the Examiner (*see* Ans. 28-32) that claim 155, when given the broadest reasonable interpretation in light of the Specification, is anticipated by Vogel. Accordingly, the rejection of claims 155-156, 160, and 174 under 35 U.S.C. § 102(e) is affirmed.

Claims 160

The Examiner and the Appellants dispute whether Vogel describes that the "data representing said characteristics of previously selected media comprises media theme information" as recited in claim 160. *See* App. Br. 39-41 and Ans. 33. The Examiner relies upon Vogel's description of classification data (i.e. "Children," "General" or "Adult") in column 4, lines 40-51 as describing this limitation. Ans. 8 and 33.

We find the Appellants' argument unpersuasive as it is not commensurate with the scope of the claim. Claim 160 does not narrowly require that data comprise the media theme, as the Appellants seem to argue (*see* App. Br. 39-41), but more broadly "media theme information."

Accordingly, the rejection of claim 160 under 35 U.S.C. § 102(e) as being anticipated by Vogel is affirmed.

Claim 176

The Examiner and the Appellants dispute whether Vogel describes that "the data representing characteristics comprises a description of media content." *See* App. Br. 44-45 and Ans. 10 and 35. The Examiner relies upon column 3, lines 37-45, 54-55, and 59-66 of Vogel as describing this limitation. *See* Ans. 10 and 35. Column 3, lines 59-66 state that the real time data comprises information which identifies which program is currently being broadcast on each channel."

Again, we find the Appellants' argument unpersuasive as it is not commensurate with the scope of the claim. Claim 176 merely requires a "description of media content" and does not restrict or define the form of the description. Claim 176 does not preclude the description from being information that identifies the program. Accordingly, the rejection of claim 176 under 35 U.S.C. § 102(e) as being anticipated by Vogel is affirmed.

Claims 162-165

Independent claim 162 recites a processor that is configured to produce a signal that is dependent on a determined correspondence between the content characteristics of previously recorded media and media within a

set of available media. In the rejection, the Examiner equates the recited degree to Vogel's classification (Ans. 8) and in the response, states: "Vogel's classification characteristic clearly represents a degree of correspondence" and "the Adult 'A' classification clearly represents the seriousness of adult content in a movie" (Ans. 33-34).

We fail to see how Vogel's classification which as the Examiner argues "represents the seriousness of adult content in a movie" describes the degree of correspondence between the content characteristics of the data specifically recited in claim 162. Therefore, we find that the Examiner erred in finding claim 162 anticipated by Vogel. Accordingly, the rejection of claim 162, and claims 163-165, dependent thereon, under 35 U.S.C. § 102(e) as being anticipated by Vogel is reversed.

Claims 175, 177, 178

As discussed above, we find that claims 175, 177, and 178 are indefinite under 35 U.S.C. § 112, second paragraph. Therefore, we reverse the rejection of claims 175, 177, and 178 under § 102(e) as being anticipated by Vogel *pro forma.* The prior art rejection must fall, *pro forma,* because it necessarily is based on speculative assumption as to the meaning of the claims. *See In re Steele,* 305 F.2d 859, 862-63 (CCPA 1962). It should be understood, however, that our decision in this regard is based solely on the indefiniteness of the claimed subject matter and does not reflect on the adequacy of the prior art evidence applied in support of the rejections

Claims 179, 180, and 181

Similar to the limitation at issue with respect to claim 162 above, claim 179 recites a step of determining a degree of correspondence of prior selection and a set of available media. The Examiner relies upon the same findings at issue with respect to claim 162 above to reject claim 179. *See* Ans. 37. For the same reasons as discussed above with respect to claim 162, the rejection of claim 179, and claims 180 and 181, dependent thereon, under 35 U.S.C. § 102(e) as being anticipated by Vogel is reversed.

Claim 182

Similar to the limitation at issue with respect to claim 162 above, claim 182 recites a step of determining a degree of correspondence between content-dependent characteristics of available media and previously selected media. Again, the Examiner relies upon the same findings at issue with respect to claim 162 above to reject claim 182. *See* Ans. 37. For the same reasons as discussed above with respect to claim 162, the rejection of claim 182 under 35 U.S.C. § 102(e) as being anticipated by Vogel is reversed.

Claims 183-189

The Examiner rejected claim 183 by referring to their rejection of claim 155, 162, and claim 177. Ans. 13. However, the scope of claim 183 differs from claims 155, 162, and 177. For example, claim 183 recites: "automatically determining *a relation* between the available media and the media previously selected by the respective user, based on *respective plurality content characteristics* of the available media and media previously selected by the respective user." Claims 155 and 156 instead recite, more

broadly, steps of preforming a search for or determining a *correspondence* between the media with *data representing content characteristics*. The Examiner's rejection does not address these narrower limitations in the rejection. Therefore, we find that the Examiner has failed to establish a prima facie showing that claim 183 is anticipated. Accordingly, the rejection of claim 183, and claims 184-189, dependent thereon, under 35 U.S.C. § 102(e) as being anticipated by Vogel is reversed.

The rejection of claims 157-159 and 166 under 35 U.S.C. §103(a) as being unpatentable over Vogel and Young Claims 157 and 158

The Appellants argued claims 157 and 158 as a group. *See* App. Br. 55. We select claim 157 as the representative claim for this group, and the remaining claim 158 stands or falls with claim 157. 37 C.F.R. § 41.37(c)(1)(vii) (2010).

The Appellants and the Examiner dispute whether the combination of Vogel and Young teaches claim 157. *See* App. Br. 54-55 and Ans. 39-40.

We find the Appellants' arguments unpersuasive as they are not commensurate with the scope of the claim. The Appellants' arguments are based on the "predetermined correspondence criteria" recited in claim 157 referring to the "characteristics corresponding to, but not identical to previously selected media" recited in claim 155. App. Br. 55. However, this is not required by the claims. Claim 157 depends upon claim 155 and recites: "wherein the step of automatically issuing a notification includes the step of producing a display including a list of the available media meeting a predetermined correspondence criteria on a display screen for viewing."

Nothing in claim 157 requires that the predetermined correspondence criteria be the same as the characteristics recited in claim 155.

Accordingly, the rejection of claims 157 and 158 under 35 U.S.C. § 103(a) as being unpatentable over Vogel and Young is affirmed.

Claim 159

The Appellants provide no separate arguments against the rejection of claim 159 under 35 U.S.C. § 103(a) as being unpatentable over Vogel and Young. *See* App. Br. 54 and 55. Accordingly, we shall affirm this rejection.

Claim 166

This rejection is directed to a claim dependent on claim 162, whose rejection we have reversed above. For the same reasons, we will not sustain the rejection of claim 166 over the cited prior art. *Cf. In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992) ("[D]ependent claims are nonobvious if the independent claims from which they depend are nonobvious.") We note that the Examiner did not rely upon Young to cure the deficiencies of Vogel discussed above.

The rejection of claims 167 and 190-191 under 35 U.S.C. § 103(a) as being unpatentable over Vogel and Campbell.

These rejections are directed to claims dependent on claims 162 and 183, whose rejection we have reversed above. For the same reasons, we will not sustain the rejections of claims 167 and 190-191 over the cited prior art. *Cf. In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992) ("[D]ependent claims are nonobvious if the independent claims from which they depend are

nonobvious.") We note that the Examiner did not rely upon Campbell to cure the deficiencies of Vogel discussed above.

The rejection of claims 168-173 and 192-193 under 35 U.S.C. § 103(a) as being unpatentable over Vogel and Wachob

Claim 168-173

Claim 168 recites an apparatus which includes a processor that is structured to search for media item and present a recommendation based on a degree of correspondence of the selection on content characteristics of the available media. In rejecting claim 168, the Examiner relies upon the same findings at issue with respect to claim 162 above to teach the limitation at issue with respect to claim 168. *See* Ans. 16. We note that the Examiner does not rely upon any teachings from Wachob to teach the limitation at issue. *Id.* For the same reasons as discussed above with respect to claim 162, we reverse the rejection of claim 168, and claims 169-173, dependent thereon, under 35 U.S.C. § 103(a) as being unpatentable over Vogel and Wachob.

Claims 192 and 193

This rejection is directed to claims dependent on claim 183, whose rejection we have reversed above. For the same reasons, we will not sustain the rejections of claims 192 and 193 over the cited prior art. *Cf. In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992) ("[D]ependent claims are nonobvious if the independent claims from which they depend are nonobvious.") We note that the Examiner did not rely upon Wachob to cure the deficiencies of Vogel discussed above.

DECISION

The decision of the Examiner to reject claims 155-161, 174, 176 and 177 is affirmed and to reject claims 162 –173, 175 and 178-193 is reversed. We enter a new ground of rejection on claims 175 and 178.

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 C.F.R. § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 C.F.R. § 41.50(b) also provides that the Appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

- (1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner . . . .
- (2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record . . . .

AFFIRMED-IN-PART; 37 C.F.R § 41.50(b)

JRG